REMARKS

Claims 1-32 are pending in the instant application. The Claims are subject to a Restriction Requirement under 35 U.S.C. §121. Applicants hereby elect, with traverse, an invention and a species falling within that invention.

The Examiner requires restriction of the application to one of the following invention groups:

Group I: Claims 1-12 and 26-32, drawn to methods and compositions for treating cancer with an enhanced combination of a phenyl-protein transferase inhibitor and an antineoplastic agent.

Group II: Claims 13-25, drawn to methods for treating cancer with an enhanced combination of a phenyl-protein transferase inhibitor and radiation therapy.

Applicants hereby elect, with traverse, the invention of Group I. The species of a specific combination of the prenyl-protein transferase inhibitor which is 1-(3-Chlorophenyl)-4-[1-(4-cyanobenzyl)-5-imidazolylmethyl]-2-piperazinone, and a tubule-stabilizing agent which is paclitaxel is also elected for examination.

Applicants note that the identification of the prenyl-protein transferases as targets for a potential anti-cancer agent has been established and a considerable effort has been expended in both the scientific community and the pharmaceutical industry in the identification of an inhibitor of prenyl-protein transferases and the use of such an inhibitor, in particular in the treatment of cancer. Applicants note, however, that the research in the area of prenyl-protein transferase inhibitors has taken place only in the last ten (10) years

prior to the earliest priority date accorded the instant application. Applicants therefore respectfully contend that a search of the scientific and patent art in the ten years prior to June, 2001 (the filing date of the international application of which this is the U.S. national phase), for any disclosure of a prenyl-protein transferase inhibitor or farnesyl-protein transferase inhibitor in combination with another therapeutic agent should be comprehensive with respect to the invention as originally claimed, yet would not be an undue burden on the Examiner.

Applicants note MPEP 803 provides:

> There are two criteria for a proper requirement for restriction between patentably distinct inventions:
> (1) The inventions must be independent or distinct as claimed; and
> (2) There must be a serious burden on the examiner if restriction is not required.

Because there would be no serious burden on the Examiner in searching such a narrowly defined invention in such a recently initiated area of research, Applicants respectfully contend that the restriction requirement set forth by the Examiner is improper and should be withdrawn.

The Examiner has requested a copy of the PTO 1449 forms which accompanied the IDS. Applicants contend that those forms were properly submitted with the IDS of May 24, 2000. Applicants have attached copies of the forms to this response.

Applicants respectfully contend that the Examiner's "Restriction Requirement has been addressed and obviated by the above remarks, and that Claims 1-32 are allowable and

an early Notice of Allowance is earnestly solicited. If a telephonic communication with Applicants' representative will aid in the advancement of the prosecution of this application, please telephone the representative indicated below.

Respectfully submitted,

By: _____

David A. Muthard
Reg. No. 35,297
Attorney for Applicant(s)

MERCK & CO., INC.
P.O. Box 2000
Rahway, New Jersey 07065-0907
(732) 594-3903

Date: August 2, 2001